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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/521,177	03/08/2000	Teruyuki Shitara	7217/61065	1416

7590 05/07/2004  
Jay H Maioli  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

ZIA, MOSSADEQ

ART UNIT PAPER NUMBER

2134

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/521,177

Applicant(s)

SHITARA ET AL.

Examiner

Mossadeq Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 08 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent No.

5,787,171 Kubota et al in further view of Patent No. 6,389,538 Gruse et al.

2. Regarding independent claim 10, Kubota discloses an information distribution system comprising:

a server apparatus being connected to a terminal apparatus for supplying coded main data to the terminal apparatus, the server apparatus including:

memory (data base) means for recording at least one coded main data; and  
(Kubota, fig. 1, label 1, col. 1, line 35-36)

transmitting means for transmitting to the terminal apparatus the coded main data that is read out from the memory means (Kubota, fig. 1, label 3, col. 4, line 16-19); and

the terminal apparatus for decoding and reproducing coded main data including:

receiving means for receiving the coded main data that is transmitted from the transmitting means of the server apparatus (Kubota, fig. 1, label 6; col. 4, line 21-23);

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recording means (magneto-optical disk) for recording the coded main data (Kubota, fig. 1, label 6; col. 7, line 13-14, 35, 44-45);

decoding means for decoding the coded main data that is one of received by the receiving means and recorded in the recording means (Kubota, fig. 1, label 6; col. 7, line 38);

but fail to show judging means for judging whether the terminal apparatus is connected to the server apparatus; and

control means for controlling the decoding means to decode the coded main data received by the receiving means when the judging means judges that the terminal apparatus is connected to the server apparatus, and for controlling the decoding means to decode the coded main data that is recorded in the recording means when the judging means judges that the terminal apparatus is not connected to the server apparatus.

However, Gruse teaches End-User Device(s) (implies server-terminal relation exist from Content Provider to End-User Device (Gruse, col. 11, line 66-67)) manages (judging means) the download and storage of SCs containing the Digital Content (main data, Gruse, col. 14, line 34-36). Processes the watermark(s) every time the Digital Content is copied or played (decoding means, col. 14, line 37-28); manages the number of copies made (or deletion of the copy) in accordance with the Digital Contents's Usage Condition (control means, Gruse, col. 14, line 39-41); and performs the copy to an external media or portable consumer device if permitted (Gruse, col. 14, line 41-42). Furthermore, Gruse teaches Usage Conditions may specify the number of plays and local copies allowed for the Content, and whether or not the Content may be recorded to an

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external portable device (recording means when terminal not connected to server, Gruse, col. 22, line 40-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kubota et al. as per teaching of Gruse et al. to gain the advantage of providing a system for tracking usage of digital content on user devices (Gruse, col. 6, line 11-12).

3. Regarding claim 11-19, rejections from the previous Office Action stands.

***Response to Amendment***

4. Applicant's arguments filed page 13, line 7-10 have been fully considered but they are not persuasive. Applicant contests that the judging means judges whether the terminal apparatus is connected to the server apparatus. It is well known in the art that in a data transmitting system judgment of connection occurs when transferring data between local or remote transmitter/receiver systems to aid in maintaining integrity of the transmitted data. This implies, as an example, that if the connection were to be severed prematurely the system would be able to determine that the active terminal and server connection no longer exist. Therefore, it can be observed that if integrity is not maintained then the main data is not reproducible. Furthermore, a newly formed rejection is presented regarding claim 10. Thusly the rejection for claim 10 and the remaining claims 11-19 stands.

5. Claims 1-8 are allowed.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mossadeq Zia whose telephone number is 703-305-8425. The examiner can normally be reached on Monday-Friday between 8:30am-5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mossadeq Zia  
Examiner  
Art Unit 2134

mz  
5/3/04

  
GREGORY MORSE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100